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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,823	10/09/2000	Ellen H. Filvaroff	P1834	4430

9157 7590 08/26/2003
GENENTECH, INC.
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EXAMINER

JIANG, DONG

ART UNIT PAPER NUMBER

1646

DATE MAILED: 08/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/685,823

Applicant(s)

FILVAROFF, ELLEN H.

Examiner

Dong Jiang

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,21,23-29,37 and 39-46 is/are pending in the application.
- 4a) Of the above claim(s) 41-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,21,23-29,37,39,40,45 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,3-9,21,23-29,37 and 39-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED OFFICE ACTION

The request filed on 31 March 2003, paper No. 15, for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/685,823 is acceptable, and a RCE has been established. An action on the RCE follows.

Currently claims 1, 3-9, 21, 23-29, 37, 39-46 are pending, and claims 1, 3-9, 21, 23-29, 37, 39, 40, 45 and 46 are under consideration.

Rejections Over Prior Art:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 3-6, 8, 9, 21-26, 28, 29, 37, 39, 40, and 45 remain rejected under 35 U.S.C. 102(a) as being anticipated by Shigeru et al., JP2000186046 (July 4, 2000) for the reasons cited in the previous Office Action, paper No. 6, at page 6.

Applicants argument, filed on 08 July 2002 (paper No. 12) has been fully considered, but is not deemed persuasive for reasons set forth in the final Office Action, paper No. 13, at pages 2-3.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 8, 9, 21, 23-26, 28, 29, 37, 39, 40, and 45 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Chabaud et al. (J. Immunol., 1998, 161:409-414), in

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view of Carroll et al. (Inflammation Research, 47:1-7, 1998) for the reasons cited in the previous Office Action, paper No. 6, at pages 7-8.

Applicants argument in paper No. 12 has been fully considered, but is not deemed persuasive for reasons set forth in the final Office Action, paper No. 13, at pages 3-5.

Claims 1-4, 8-9, 13, 14, 21-26, 28, 29, 33, 34, 37-39 and 45 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kotake et al. (J. Clin. Invest., 1999, 103:1345-1352), and Chabaud et al. (Arthritis & Rheumatism, 1999, 42:963-970), in view of Carroll et al. (Inflammation Research, 47:1-7, 1998) for the reasons cited in the previous Office Action, paper No. 6, at page 8, and the reasons set forth in the final Office Action, paper No. 13, at page 5.

Claims 1, 3-9, 21, 23-29, 37, 39, 40, 45, and 46 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Troutt (WO 98/23284), in view of Chabaud et al. (J. Immunol., 1998, 161:409-414), for the reasons cited in the last Office Action, paper No. 10, at pages 6-7.

Applicants argument in paper No. 12 has been fully considered, but is not deemed persuasive for reasons set forth in the final Office Action, paper No. 13, at page 6.

Conclusion: No claim is allowed.

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Advisory Information:

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 703-305-1345. The examiner can normally be reached on Monday - Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Elizabeth C. Kemmerer

ELIZABETH KEMMERER
PRIMARY EXAMINER

Dong Jiang, Ph.D.
Patent Examiner
AU1646
8/18/03